

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claim 9 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the inventions are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for using the product as claimed can be practiced with another materially different product, such as a cationic electrodeposition coating that does not comprise an epoxy resin.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 9 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Retzlaff et al. (US 2003/0150729) in view of Hunakoshi et al. (U.S. Pat. 6,054,033).

Regarding claims 1 and 6: Retzlaff et al. teaches a cationic (para. 20) electrodepositable composition (para. 1) comprising a cationic epoxy resin (para. 20), polymer additive/resin fine particles (para. 12) with a particle size of 2-15 microns (para. 17), which overlaps the claimed range, in an amount of 10-25 weight percent (para. 21), which overlaps the claimed range. Retzlaff et al. also teaches a composition with 8% pigments based on the weight of the resin solids (table 5).

Retzlaff et al. does not disclose a blocked isocyanate curing agent. However, Hunakoshi et al. teaches a similar composition with a blocked polyisocyanate crosslinker (col. 1 line 52). Retzlaff et al. and Hunakoshi et al. are analogous art since they are both concerned with the same field of endeavor, namely cationic electrodeposition compositions with epoxy resins and resin fine particles. At the time of

the invention a person having ordinary skill in the art would have found it obvious to combine the blocked polyisocyanate crosslinker of Hunakoshi et al. with the composition of Retzlaff et al. and would have been motivated to do so for such desirable properties as anti-corrosiveness and non-yellowing properties, as evidenced by Hunakoshi et al. (col. 5 lines 10-24).

Regarding claim 2: Retzlaff et al. teaches the specific gravity/density is in a range of 1.05-1.35 (para. 16), which overlaps the claimed range.

Regarding claim 5: Retzlaff et al. teaches the pigments are optional, and that instead of pigments transparent polymer additives could be incorporated depending on the needs of the user (para. 22). Therefore, at least one embodiment of Retzlaff et al. does not comprise pigments.

Regarding claims 7 and 8: Retzlaff et al. teaches 4% pigment is used in the example in Table 7.

### ***Response to Arguments***

Applicant's arguments filed June 16, 2008 have been fully considered but they are not persuasive, because:

A) Applicant's argument that Retzlaff et al. does not disclose the size and amount of particles of the claimed invention is not persuasive. As set forth above, Retzlaff et al. teaches a particle size of 2-15 microns (para. 17), which overlaps the claimed range, in an amount of 10-25 weight percent (para. 21).

B) Applicant's argument that Retzlaff et al. does not disclose an improvement in the "cissing-preventing property" is not persuasive. This limitation is not claimed. Further if it were claimed, it would be the Office's position that since all the claimed components are present, this property would be implicit to the composition of Retzlaff et al.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Megan McCulley whose telephone number is (571)270-3292. The examiner can normally be reached on Monday - Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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